

## **REMARKS**

### **I. Status of the Claims**

In the final Office Action mailed October 10, 2008, the Examiner objected to claim 37; and rejected claims 1-3, 6-8, 11, 15-18, 21-26, 28-33, 36-41, and 43-45 under 35 U.S.C. § 103(a), as being unpatentable over *Marshall* (U.S. Patent Publication No. 2002/0116266) in view of *Walker et al.* (U.S. Patent No. 6,018,718), and in view of the Examiner's Official Notice.

By this Amendment, Applicants amend claims 1, 3, 6, 8-11, 13, 16, 18, 21-26, 28, 31, 33, 36-41, and 43. Claims 4, 5, 12, 19, 20, 27, 34, 35, and 42 were previously canceled. Claims 1-3, 6-11, 13-18, 21-26, 28-33, 36-41, and 43-45 remain pending in this application. By the following remarks, Applicants respectfully traverse the objection and rejection contained in the Office Action.

### **II. Objection to Claim 37**

With this response, Applicants have corrected the typographical error in claim 37. Accordingly, Applicants request that the objection to claim 37 be withdrawn.

### **III. Rejections of Claims 1-3, 6-8, 11, 15-18, 21-26, 28-33, 36-41, and 43-45 Under 35 U.S.C. § 103(a)**

Applicants respectfully traverse the rejection of claims 1-3, 6-8, 11, 15-18, 21-26, 28-33, 36-41, and 43-45 under 35 U.S.C. § 103(a).

"[T]he framework for the objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). . . . The factual inquiries . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the differences between the claimed invention and the prior art." M.P.E.P. § 2141(II). "Office personnel must explain why the difference(s) between the

prior art and the claimed invention would have been obvious to one of ordinary skill in the art.” M.P.E.P. § 2141(III). A *prima facie* case of obviousness has not been established at least because the Examiner does not correctly determine the scope and content of the prior art, or correctly ascertain the differences between the claimed invention and the cited references. The Examiner has not properly determined the scope and content of the prior art, at least because *Marshall, Walker et al.*, and the Official Notice, taken individually or in any proper combination, fail to disclose or suggest all the elements of amended claim 1,

*Marshall* is directed to “incentive rewards programs for influencing a variety of desirable behaviors.” *Marshall* at para. [0006]. “The incentive programs require enrollment of individuals. Enrolled individuals accumulate time points by engaging in activities specified by the programs” at “multiple participant organizations.” *Marshall* at para. [0031]-[0033]. The programs are “maintained by a program administrator,” such as “a computer system,” connected with various “computer systems of program participants.” *Marshall* at para. [0033]. “The enrollment of a new member may also occur on participant computer systems.” *Marshall* at para. [0080]. In particular, during the enrolling process, an individual can provide “individual profile information to [the] program administrator” (step 205 of FIG. 2), or to a “participant resource” such as a participant computer system (step 215 of FIG. 2) which will forward the information to the program administrator. *Marshall* at FIG. 2 and para. [0080].

In the final Office Action, the Examiner appears to interpret *Marshall*’s “participant organization,” “desirable behavior,” “time points,” and “individual profile information” as the claimed “enterprise,” “non-credit activity,” “reward,” and “contact information of the

customer,” respectively, as recited in claim 1. (Office Action at pp. 4-5.) Conceding that *Marshall* is silent about a “financial account” and a “financial institute,” the Examiner cites *Walker et al.* to allege the teaching of “awarding particularly financial accounts.” (Office Action at p. 5.) Further, the Examiner acknowledges that *Marshall* and *Walker et al.* do not disclose the “providing ... an offer to the enterprise” as previously recited in claim 1. (Office Action at p. 5.) However, to alleviate this deficiency of *Marshall* and *Walker et al.*, the Examiner takes Official Notice. Applicants respectfully disagree with the Examiner’s interpretation of the cited references and traverse the Examiner’s use of Official Notice.

*Marshall*, *Walker et al* and Official Notice, alone or in any combination, do not teach or suggest at least “identifying an enterprise unrelated to the financial institution, wherein a lower credit risk is associated with persons who engage in non-credit behavior benefiting the enterprise,” and “arranging, by the financial institution, a relationship with the enterprise to reward a person for engaging in the non-credit behavior benefiting the enterprise,” as recited by claim 1, nor is this recitation well known in the art.

First, *Marshall* does not teach or suggest a “financial institution” and an “enterprise unrelated to the financial institution” because the “multiple participant organizations” disclosed by *Marshall* are all related to the “program administrator.” For example, *Marshall* discloses that the “program administrator may be a computer system maintained by the same [participant] organization.” *Marshall* at para. [0033]. Indeed, there is no separate “enterprise” to deal with in *Marshall*’s system. This is one example of the significant differences between the claimed invention as a whole and the cited

reference. Therefore, even accepting the Examiner's interpretation of "participant organizations" as the claimed "enterprise," a position Applicants do not concede, *Marshall* still fails to teach or suggest "identifying an enterprise unrelated to the financial institution," as recited in claim 1.

Furthermore, *Marshall* does not teach or suggest "identifying an enterprise unrelated to the financial institution, wherein a lower credit risk is associated with persons who engage in non-credit behavior benefiting the enterprise," as recited in amended claim 1. Although *Marshall* discloses certain "desired behaviors" performed by the program members, *Marshall* does not teach or suggest that "a lower credit risk is associated with" these program members. Indeed, the Examiner even concedes that *Marshall* has nothing to do with "financial institution," or any financial activities. (Office Action at p. 5.) Therefore, *Marshall*'s system does not determine if a member's behavior suggests he has "a lower credit risk." The other cited references are likewise silent regarding this recited feature. And, this is another example of the many significant differences between the claimed invention as a whole and the cited reference.

In addition, *Marshall* also fails to teach or suggest "arranging, by the financial institution, a relationship with the enterprise to reward a person for engaging in the non-credit behavior benefiting the enterprise," as recited by amended claim 1. Indeed, since the "participant organizations" disclosed by *Marshall* are merely subparts of the "program administrator," there is no teaching or need for the "program administrator" to arrange "a relationship with the enterprise to reward a person for engaging in the non-credit behavior benefiting the enterprise," as recited in amended claim 1.

Neither *Walker*, cited for its alleged teaching of “financial account,” nor the Examiner’s Official Notice, taken to allege that “an offer” to the enterprise is well-known, cures the deficiencies of *Marshall*. Consequently, the cited art and the Examiner’s Official Notice fail to support the rejection of claim 1 and the Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the prior art and the claimed invention. Accordingly, the Office Action has not clearly articulated a reason as to why independent claim 1 would have been obvious to one of ordinary skill in view of the prior art. Therefore, a *prima facie* case of obviousness has not been established for independent claim 1. Applicants thereby respectfully request that the rejection of claim 1 be withdrawn and the claim allowed.

Amended independent claims 16 and 31, although of different scope than claim 1, recite similar subject matter. Accordingly, Applicants also respectfully request the withdrawal of the rejection of claims 16 and 31 under 35 U.S.C. § 103(a) and the timely allowance of these claims.

Dependent claims 2, 3, 6-11, 13-15, 17, 18, 21-26, 28-30, 32, 33, 36-41, and 43-45 are also allowable at least for the reasons set forth above in connection with independent claims 1, 16, and 31, and because they additionally recite features neither taught nor suggested by the prior art of record. Accordingly, Applicants also respectfully request withdrawal of the rejection of dependent claims 2, 3, 6-11, 13-15, 17, 18, 21-26, 28-30, 32, 33, 36-41, and 43-45 under 35 U.S.C. § 103(a) and the timely allowance of these claims.

#### IV. Official Notice

In the final Office Action, the Examiner asserts that “Applicant failed to adequately traverse the official notice,” and “per MPEP §2144.03(C), the official notice is taken to be admitted prior art because applicant’s attempted traverse was inadequate.” (Office Action at p. 12.) Applicants traverse the Examiner’s assertion.

In the Office Action dated March 10, 2008, the Examiner took an Official Notice by stating “it is old and well known in the art that business entities or service providers seeking to enter business relationships with other entities ... by presenting an offer to the perspective participant” without mentioning or addressing all the features recited in Applicants’ claim element. (03/10/2008 Office Action at p. 8.) In Applicants’ Reply to Office Action filed June 10, 2008, Applicants traversed the Official Notice. M.P.E.P. §2144.03(C) requires that “to adequately traverse ... a finding [of an official notice], an applicant must specifically point out the supposed errors in the examiner’s action, which would include stating why the noticed fact is not considered to be common knowledge.” Applicants’ traverse met these requirements. In particular, Applicants pointed out that “it is not appropriate for the Examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known.” See M.P.E.P. § 2144.03(A), the procedures set forth in the Memorandum by Stephen G. Kunin, Deputy Commissioner for Patent Examination Policy dated February 21, 2002, and the precedents provided in *Dickinson v. Zurko*, 527 U.S. 150, 50 U.S.P.Q.2d 1930 (1999) and *In re Ahlert*, 424 F.2d, 1088, 1091, 165 U.S.P.Q. 418, 420 (CCPA 1970). Applicants specifically pointed out that the claimed element does not merely recite “providing an offer to an enterprise,”

but instead expressly recites that the offer comprises “an offer to provide the reward to the financial account for the customer in exchange for the customer to further engage in the non-credit behavior.” Applicants specifically pointed out that these features are not well known in the context of managing a financial account, and that the Examiner erred in failing to address these features. Further, Applicants submitted that the Official Notice is improper because the Examiner relies solely on “common knowledge” without evidentiary support in the record as the principal evidence upon which a rejection is based, rather than using the asserted knowledge to “fill in the gaps” in an insubstantial manner.

Now, for the first time, the Examiner takes the position that the claim features that Applicants pointed out as being not well-known in the art should not be given patentable weight. (Office Action at 12.) The Examiner cites no authority and provides no logical reasoning to support this position. Moreover, Applicants disagree and traverse the Examiner’s decision to selectively ignore claim features. And, contrary to the Examiner’s assertion, Applicants have adequately traversed the Official Notice in the 06/10/08 Reply and the Official Notice should not be taken as admitted prior art. Applicants again request that the Examiner provide evidence to support the finding that the entire claim element is well known in the art. M.P.E.P. §2144.03(C)

For this additional reason, the rejection of claims 1-3, 6-8, 11, 15-18, 21-26, 28-33, 36-41, and 43-45 under 35 U.S.C. § 103(a) is legally deficient, should be withdrawn and claims allowed.

**V. Conclusion**

The preceding remarks are based on the arguments presented in the Office Action, and therefore do not address patentable aspects of the invention that were not addressed by the Examiner in the Office Action. The pending claims may include other elements that are not shown, taught, or suggested by the cited art. Accordingly, the preceding remarks in favor of patentability are advanced without prejudice to other bases of patentability. Furthermore, the Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account 06-0916.

Respectfully submitted,

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Dated: March 10, 2009

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